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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,097

Applicant(s)

MCCORVEY, ROBERT L.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 13, it is not clear/enabling which structure is encompassed by the means plus function limitation of "a means for securing...." for purposes of examination it is assumed that applicants frame portion (20) is intended to encompass the above limitation.

Regarding claim 14, the limitation of "rollers for rollably contacting a surface of the circular pipe" is not clear. It would appear that applicants are claiming rollers (22), however although the specification states that the rollers contact the circular pipe, figure 1 shows the rollers contacting the elliptical structure and not a circular pipe structure. Therefore the positioning of the frame, roller assembly in relation to the elliptical and circular structure is not clear and not enabling.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the dimension of a diameter being greater than 48 inches is not clear since the shape is elliptical.

The remainder of the action considers the claims as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellzey '435. Ellzey discloses an apparatus and method for spirally forming a multi-layered tube containing all of the claimed elements including, with reference to claim 13, a rigid elliptically shaped body having an interior and exterior surface (figure 13), a means for securing the elliptically shaped body (frame members 23, 22, 41) to a circular pipe forming machine (machine shown in figure 8). A frame (24) with rollers (R), as required by claim 14, is shown in figure 8. A cross bar and beam, as required by claim

15, are shown as elements 31 and 38, respectively. Insert elements removably positioned between breaks are shown as plates 33 and described in col. 6, lines 36-45.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellzey '435. Although Ellzey does not specify any particular size for his elliptical member it would have been obvious to manufacture the elliptical member with a size dimension being greater than 48 inches and required by claim 16 since it would only depend on the final product to be manufactured, especially since Ellzey envisions that his elliptical structure may be an airplane wing (col. 5, lines 62+) where such structure are commonly known to have dimensions greater than 48 inches.

Claims 13, 17-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castricum '481 in view of Ellzey '435. Castricum discloses a pipe forming machine which teaches all of the claimed elements including the use of outwardly positioned flanges (66a) and respective bolts (67) in order to secure the various body pieces together, however the reference fails to teach an elliptically shaped body as required by claim 1, removable insert elements as required by claim 17 and a pipe having a

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diameter greater than 48 inches as required by claim 20. However, Ellzey discloses a machine like that of Castricum which teaches the use of an elliptically shaped core member (figure 13) made up of removable insert elements (plates 33 and described in col. 6, lines 36-45) with such machines for the purpose of manufacturing a variety of different items. Therefore it would have been obvious to manufacture the device of Castricum with an elliptically shaped core body made of removable insert elements for the purpose of manufacturing a variety of different items (by repositioning of the elements) where the positioning of the elliptically shaped member with respect to the machine and a particular diameter size would have been obvious for the purpose of making the variously sized machine pieces fit and for producing various items known to have different size dimensions.

Allowable Subject Matter

Claims 1-12 allowed.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dmitry Suhol
Primary Examiner
Art Unit 3725

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